

REMARKS

Claim 1 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite in failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants believe that claim 1, as originally submitted, does satisfy 35 U.S.C. § 112, second paragraph, but claim 1 has been amended to specifically describe that the polyurethane adhesive is applied to the area so that the polyurethane adhesive will prevent galvanizing material from adhering to the area, upon which the polyurethane adhesive has been applied, during subsequent galvanizing of the member. Applicants further submit that the term "polyurethane adhesive" does comply with 35 U.S.C. § 112, second paragraph. For example, in the prior art publication to Seiichi JP06-235055, reference is made to adhesive material and it is believed that the claims in the application, by stating "polyurethane adhesive," are in compliance with 35 U.S.C. § 112.

The Examiner also indicated that claims 7 and 8 would be allowable if rewritten in independent form. Accordingly, claim 7 has been cancelled without prejudice and rewritten as newly submitted claim 9. Claim 8 has been amended to depend from claim 9. Accordingly, claims 9 and 8 should be in condition for allowance.

Claims 1-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Seiichi in view of Horiki. Seiichi does not teach the use of a polyurethane adhesive as described in the specification and as set forth more fully in the claims. Seiichi utilizes a thermoset or thermoplastic "cheap plastic" and does not even remotely suggest that a polyurethane adhesive itself could be utilized as the sole means of masking the area

1 in question. Further, Horiki does not teach anything remotely similar to that described
by applicants in the specification and the claims. In applicants' invention, the
polyurethane adhesive is the masking agent while in Horiki, the masking element is
secured to the metal by an adhesive agent. In other words, Horiki's adhesive material
5 is not the masking element but only secures the masking element to the metal
material.

In determining the differences between the prior art and the claims, the question
under 35 U.S.C. § 103 is not whether the differences themselves would have been
10 obvious, but whether the claimed invention as a whole would have been obvious.
Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). A
prior art reference must be considered in its entirety, *i.e.*, as a whole, including
portions that would lead away from the claimed invention. W.L. Gore & Associates,
Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). Distilling an
15 invention down to the "gist" or "thrust" of an invention disregards the requirement of
analyzing the subject matter "as a whole". Id. Impermissible hindsight must be
avoided and the legal conclusion must be reached on the basis of the facts claimed
from the prior art. MPEP § 2142.

20 The prior art must suggest the desirability of the claimed invention. There are
three possible sources for a motivation to combine or modify a reference: the nature of
the problem to be solved, the teachings of the prior art, and the knowledge of persons
of ordinary skill in the art. In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453,
1457-58 (Fed. Cir. 1998) (stating that the combination of references taught every
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1 element of the claimed invention, however without a motivation to combine, a rejection
based on a *prima facie* case of obviousness was held improper). Furthermore, the
fact that references can be combined or modified is not sufficient to establish *prima*
5 *facie* obviousness. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).
(Emphasis provided). Although a prior art device "may be capable of being modified to
run the way the apparatus is claimed, there must be some suggestion or motivation in
the reference to do so." *Id.* Also, a statement that "modifications of the prior art meet
the claimed invention would have been 'well within the ordinary skill of the art at the
10 time the invention was made because the references relied upon teach that all aspects
of the claimed invention were individually known in the art' is not sufficient to establish
a *prima facie* case of obviousness without some objective reason to combine or modify
the teachings of the references." Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat.
App. & Inter. 1993); see also, In re Kotzob, 217 F.3d 1365, 1371, 55 USPQ2d 1313,
15 1318 (Fed. Cir. 2000) (the court reversed an obviousness rejection involving a
technologically simple concept because there was no finding as to the principle or
specific understanding within the knowledge of a skilled artisan that would have
motivated the skilled artisan to make the claimed invention).

20 Applicants assert that there is no suggestion or motivation whatsoever to modify
the prior art as the Examiner has proposed. The Examiner merely makes a blanket
rejection that the limitations of the claims would have been obvious. Again, as set
forth above, the Examiner is not allowed to make such a rejection.

1 Moreover, to establish *prima facie* obviousness of a claimed invention, all of the
claimed limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d
981, 180 USPQ 580 (CCPA 1974). All words in the claim must be considered in
judging the patentability of the claim against the prior art. In re Wilson, 424 F.2d 1382,
5 1385, 165 USPQ 494, 496 (CCPA 1970).

The Examiner's cited prior art does not teach or otherwise suggest the
limitations of the claims in this application. Accordingly, applicants assert that the
claims in this application are allowable over the Examiner's 35 U.S.C. § 103(a)
10 rejection.

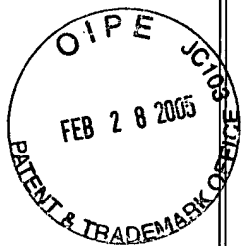
No fees or extensions of time are believed to be due in connection with this
Amendment; however, please consider this a request for any extension inadvertently
omitted and charge any additional fees to Deposit Account No. 502093.

15 Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that the original of this AMENDMENT for LONNIE E. JARVIS, ET AL., Serial No. 10/776,107, was mailed by first class mail, postage prepaid, to Mail Stop Amendment, Commissioner for Patents, Alexandria, VA 22313, on this 24th day of February, 2005.



DENNIS L. THOMTE